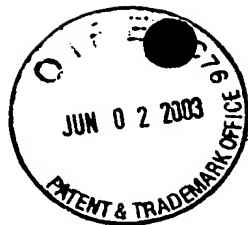


217662US3



6/6/03  
#7

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Keizo OHNISHI, et al.

SERIAL NO: 10/032,035

FILED: DECEMBER 31, 2001

FOR: GAS TURBINE COMBUSTOR

:

: EXAMINER: KIM, T

:

: GROUP: 3746

**RECEIVED**

JUN 03 2003

TECHNOLOGY CENTER R3700

**PROVISIONAL ELECTION**

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Election of Species Requirement stated in the Official Action dated May 1, 2003, Applicants provisionally elect Species X (Figures 12 and 13), and identify Claims 12 and 17 as readable on the elected species.

Applicants respectfully traverse the outstanding election requirement for several reasons.

First, the outstanding Office Action simply provides a conclusory statement that "[t]his application contains claims directed to the ... patentably distinct species of the claimed invention ...," and does not present any particular reasons for such a holding. However, MPEP §816 states the following:

If the particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given....

Hence, Applicant respectfully submits that in the absence of any annunciated basis, the PTO has not carried its burden of proof stated in MPEP §816.

Further, MPEP §806.04(f) states:

Claims to be restricted to different species must be mutually exclusive.

The outstanding Election Requirement omits any statement or basis for finding the Claims “mutually exclusive.” Therefore, the PTO has not carried the burden implied by MPEP §806.04(f), and on that basis, Applicant further traverses the Election Requirement.

Furthermore, MPEP §803 states the following:

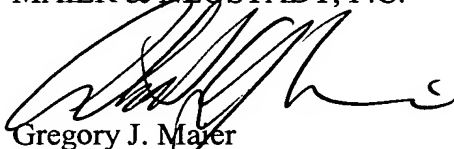
If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Claims 1-20 of the present application are all directed to gas turbine combustors, and the Office Action acknowledges that Claim 1 as generic. Thus, it appears that all the pending claims in the present application are part of an overlapping search area and that a search for Claims 12 and 17 would necessarily include a search directed to the other claims readable on the non-elected species as well. Applicant therefore respectfully submits that there is no undue burden on the Examiner to search all the claims under MPEP §803, and traverses the Election of Species Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Accordingly, it is respectfully requested that the requirement to elect a single disclosed species be withdrawn, and that a full examination on the merits of each of Claims 1-20 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Gregory J. Maier  
Attorney of Record  
Registration No: 25,599  
Akihiro Yamazaki  
Registration No: 46,155



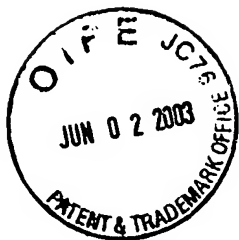
**22850**

Tel: (703) 413-3000

Fax: (703) 413-2220

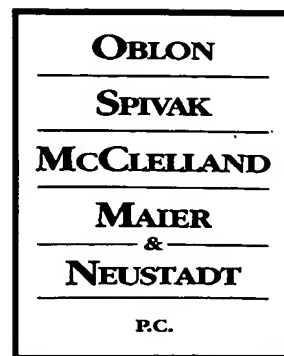
GJM/AY:fm

I:\ATTY\AKY\21s\217662\elect.WPD



Docket No.: 217662US3

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

GREGORY J. MAIER  
(703) 413-3000  
GMAIER@OBLON.COM

AKIHIRO YAMAZAKI  
(703) 413-3000  
AYAMAZAKI@OBLON.COM

RE: Application Serial No.: 10/032,035  
Applicants: Keizo OHNISHI, et al.  
Filing Date: December 31, 2001  
For: GAS TURBINE COMBUSTOR  
Group Art Unit: 3746  
Examiner: KIM, T

**RECEIVED**

JUN 03 2003

TECHNOLOGY CENTER R3700

SIR:

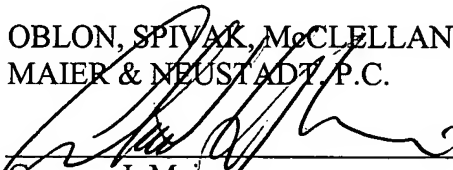
Attached hereto for filing are the following papers:

**RESPONSE TO ELECTION REQUIREMENT**

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

  
Gregory J. Maier

Registration No. 25,599



22850

(703) 413-3000 (phone)  
(703) 413-2220 (fax)  
I:\USER\FMWIN\21S\217662\SHTCOV.DOC

Akihiro Yamazaki  
Registration No. 46,155